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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,978	06/10/2004	Lydia Breck	03292.101070.3	3977
66569	7590	05/27/2009	EXAMINER	
FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			VEZERIS, JAMES A	
			ART UNIT	PAPER NUMBER
			3693	
			MAIL DATE	DELIVERY MODE
			05/27/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/709,978	BRECK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAMES A. VEZERIS	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 March 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 4-7 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 4-7 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

### **Detailed Action**

#### **Pre-Exam Formalities**

1. Receipt is acknowledged of a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission, filed on 3/06/2009.
2. Claims 1-3 have been cancelled. Claims 4-7 are currently pending.
3. Examiner James Vezeris will be reviewing the application at the request of James Kramer. Examiner Vezeris notes that all prior correspondence between Jared Newton and the applicant has been reviewed.

#### **Response to Applicant's Arguments**

4. Applicant's arguments filed 3/6/09, with respect to the rejection(s) of claim(s) 4-7 under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Walker and Chasko.

#### **Claim Rejections- 35 U.S.C. 101**

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process"

under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

#### **Claim Rejections- 35 U.S.C. 112 2nd Paragraph**

6. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: receiving, by a merchant, an account number of a user, from the user. As the claim stands, supposedly a merchant receives an account number and submits it to a provider. It is unclear if the user gives the number to the merchant. Further the submitting step should be executed by the merchant. Further claim 4 needs to include who is performing the issuing step and who is receiving the results of the issuing step. Many of these rejections are applicable to claim 7.

8. Claims 4 and 7 are rejected for being vague on whom a provider is. A provider should be the issuer of the account number. As the claim language stands a provider could be the user or issuer.

### **Claim Rejections- 35 U.S.C. 103(a)**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6163771 to Walker in view of US Patent 6738749 to Chasko.

Regarding Claim 4.

Walker teaches a method including, receiving an account number of a user, a user requesting a secondary transaction number in lieu of returning the account number, receiving, from the provider, an authorization record referencing the STN, issuing a settlement request associated with the transaction, and wherein the settlement request includes the STN and does not include the account number. (See Fig. 3a, Columns 6-7 lines 4-3) Examiner notes that in the background of the invention Walker discusses a merchant requesting verification of an account number.

Walker fails to teach maintaining, by the merchant, a record of the transaction, wherein the merchant replaces the account number with the STN and the record does not include the account number.

Chasko teaches maintaining, by the merchant, a record of the transaction. (See Figure 6)

The claim is rejected under 35 USC 103 as obvious over Walker in view of Chasko.

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the system of Chasko the ability to record the STN. Further a simple substitution of the merchant requesting the STN in Walker would result in the applicants claim. It is within the capabilities of one of ordinary skill in the art to modify both inventions to perform the above mentioned steps.

11. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Chasko in further view of US Patent 5826241 to Stein.

Regarding Claims 5-7.

While walker and Chasko cover the above, Stein teaches:  
receiving, from a first party, a transaction dispute identifying the primary account number and relating to the transaction involving the STN; (See Col 11-12, Lines 55-8)  
retrieving transaction information from a database using the primary account number; (See Col 5 lines 55-67)  
initiating an inquiry, with a second party, that includes the STN, wherein the inquiry does not include the primary account number. (See Col. 12 lines 1-7)  
determining if a valid approval code is associated with the STN; (See Col. 12 lines 1-7)  
charging back to the second party an amount of the transaction, if a valid

approval code is not associated with the STN. (Fig. 6f)

routing the transaction dispute to a predefined STN queue based at least in part on an industry type associated with the transaction. (See Col. 12 lines 1-7)

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the system of Chasko and Walker the ability to do the above mentioned steps. Further a simple substitution of the STN is within the capabilities of one of ordinary skill in the art.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES A. VEZERIS whose telephone number is (571)270-1580. The examiner can normally be reached on Monday-alt. Fridays 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

/JAMES A VEZERIS/  
Examiner, Art Unit 3693

5/19/2009